REMARKS

Claim Rejections – 35 U.S.C. § 101

Claims 8-21 stand rejected under 35 U.S.C. § 101 as claiming an abstract idea as defined in the case *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). The Office Action states at pages 2-3:

> Analysis: Claims 8-21 are disclosed by the applicant as being a "system for controlling GUI display…". Since the claims are each a series of steps to be performed on a computer the processes must be analyzed to determine whether they are statutory under 35 USC 101.
>
> Examiner interprets that the claims 8-14 are non-statutory because they do not disclose that how a system will be able to receive at run time, retrieving an XML representation and from and displaying the GUI object with out incorporating a processor, memory, and medium. Applicant submits no substance that how a system will be able to control GUI display and carry out intended results without any medium. Therefore, claims 8-14 are not able to produce useful results so its functionality can be realized. Thus, claims 8-14 are non-statutory and rejected under 35 USC 101.
>
> Further, examiner interprets that claims 15-21 are not limited to tangible embodiments in view of applicant's disclosure, specification pages 15-19 the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., [computer readable medium]) and intangible embodiments (e.g. [transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line, a signal, etc.]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the, carrier medium and transmission media would not be statutory but storage media would be statutory.

That is, claims 8-14 are rejected under 35 U.S.C. § 101 for failing to disclose how Applicants' claims will be carried out without "incorporating a processor, memory, and medium," and claims 15-21 are rejected under 35 U.S.C. § 101 as not being limited to tangible embodiments.

Claim Rejections – 35 U.S.C. § 101 – Claims 8-14

The Office Action rejects claims 8-14 of the present application under 35 U.S.C. § 101,
taking the position that Applicants fail to disclose how claims 8-14 will be carried out
without "incorporating a processor, memory, and medium." Applicants respectfully note
in response, however, that the present claims incorporate a processor, memory, and
medium. Applicants' original specification discloses a processor and memory at
paragraph [0015], U.S. patent publication 2005/0223375, stating:

> FIG. 1 sets forth a block diagram of automated computing machinery
> represented as a computer (134) useful in controlling a GUI display for a
> plug-in in an application supporting plug-ins according to embodiments of
> the present invention. The computer (134) of FIG. 1 includes at least one
> computer processor (156) or `CPU` as well as random access memory
> (168) ("RAM"). Stored in RAM (168) is an application program (152) and
> a plug-in (104). Application programs include particular computer
> software instructions for controlling a GUI display for a plug-in in
> accordance with embodiments of the present invention.

The system recited in claims 8-14 receives at run time "in the application" a request to
display a GUI object. The 'application' recited in the claims is a computer software
application, defined generally in the Fifth Edition of the Microsoft Computer Dictionary
(Microsoft Press: 2002) as "a program designed to assist in the performance of a specific
task, such as word processing, accounting, or inventory management." In addition,
'application' is defined more specifically in the current specification, paragraph [0015] of
U.S. patent publication 2005/0223375, as including "particular computer software
instructions for controlling a GUI display for a plug-in in accordance with embodiments
of the present invention." As is well known in the art, computer program applications are
disposed within computer memory and executed on computer processors such the ones
illustrated and described in the current specification and drawings at reference numbers
168 and 156. For these reasons, a person of skill in the art would understand claims 8-14
of the present application to recite a system that includes a computer program application
disposed in computer memory and executing on a computer processor to receive a
request to display, retrieve an XML representation, and display a GUI object – all in
accordance with embodiments of the present invention as presently claimed. Computer

memory, computer processors, and GUI displays are all tangible media. A display of a GUI object is a useful result produced by the system recited in claims 8-14, and claims 8-14 therefore recite statutory subject matter under 35 U.S.C. § 101. Claims 8-14 are therefore allowable in their current form, and Applicants respectfully request reconsideration of claims 8-14 in view of these remarks.

Claim Rejections – 35 U.S.C. § 101 – Claims 15-21

Regarding the rejections of claims 15-21, the Office Action takes the position that claims 15-21 are defined as including intangible embodiments including "transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line, a signal." Applicants respectfully note in response that Applicants' claims are directed only to tangible embodiments of the invention. The present application makes no reference whatsoever, neither in the claims nor in the specification, to radio frequency (RF), infrared (IR), a carrier wave, telephone line, or a signal. The specification mentions transmission media at page 4, line 21, only as an example of a recording medium. The Fifth Edition of the Microsoft Computer Dictionary defines the term 'media' as "a physical material, such as paper, disk, and tape, used for storing computer-based information." One of ordinary skill in the art would therefore understand that 'recording medium' as claimed here is a physical material, and that claims 15-21 represent computer program product claims to which Applicants are entitled according to *In re Beauregard*, 53 F. 3d 1583 (Fed. Cir. 1995). The rejections of claims 15-21 under 35 U.S.C. § 101 are improper, and should therefore be withdrawn. Applicants respectfully request reconsideration of claims 15-21.

Claim Rejections – 35 U.S.C. § 102 Over Anderson

Claims 8-21 stand rejected under 35 U.S.C. § 102 as being anticipated by Anderson (U.S. Patent No. 6,278,750) (hereafter, 'Anderson'). To anticipate claims 8-21 under 35 U.S.C. § 102, Anderson must disclose and enable each and every element and limitation recited in the claims of the present application. As explained below, Anderson does not disclose and enable each and every element and limitation recited in the claims of the present application and therefore does not anticipate the claims of the present application.

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Anderson Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Anderson does not disclose each and every element of claim 8, and Anderson therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 8 recites:

8. A system for controlling a GUI display for a plug-in in an application supporting plug-ins, the system comprising:

means for receiving, at run time, in the application from the plug-in a request to display a GUI object, wherein the application has standards of appearance for the GUI display;

means for retrieving an XML representation of the GUI object in response to the request that complies with the application's standards of appearance for the GUI display; and

means for displaying the GUI object in dependence upon the retrieved XML representation of the GUI object.

**Anderson Does Not Disclose Means
For Receiving, At Run Time, In The
Application From The Plug-In A Request
To Display A GUI Object, Wherein
The Application Has Standards Of
Appearance For The GUI Display**

The Office Action takes the position that Anderson at column 2, lines 5-16, discloses the
first element of claim 8: means for receiving, at run time, in the application from the
plug-in a request to display a GUI object, wherein the application has standards of
appearance for the GUI display. Applicants respectfully note in response, however, that
what Anderson at column 2, lines 5-16, in fact discloses is:

> The invention embodies the following main concepts: 1. A multi-tiered
> application is composed of three types of objects: Graphical User Interface
> (GUI) objects--Centrally developed objects which allow the user to
> interact (e.g., view, create, modify) with enterprise data. GUI objects can
> be composites of other GUI objects. Business Logic (BL) objects--Objects
> which provide analysis, transformation, validation and other services on
> enterprise data. Enterprise Data Adapter (EDA) objects--Objects which
> transfer data between the tiers of a multi-tiered network application,
> including the persistent enterprise data store

That is, Anderson at column 2, lines 5-16, discloses a multi-tiered application including
centrally developed GUI objects. Anderson's multi-tiered application including centrally
developed GUI objects does not disclose means for receiving, at run time, in the
application from the plug-in a request to display a GUI object, wherein the application
has standards of appearance for the GUI display as claimed in the present application.
Anderson does not disclose receiving a request to display a GUI object from a plug-in,
and Anderson does not disclose standards of appearance for the GUI display. A request
to display a GUI object, as claimed in the present application, is expressly received by the
application from a plug-in. In contrast to the claims of the present application, Anderson
discloses that a GUI object is displayed only after a centralized configuration server
sends a configuration document to a bootstrap application running on a local computing
node. The bootstrap application subsequently retrieves the code specified in the
configuration document, instantiates the objects involved in the application, and creates

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the initial user interface for the application. *See*, Anderson at column 3, lines 45-67. Anderson in no way discloses an application receiving a request to display a GUI object from a plug-in, as Anderson makes no disclosure whatsoever indicating that Anderson's dynamically constructed multi-tiered application supports plug-ins. In fact, the term "plug-in" is not used at any point in Anderson – not even once. Because Anderson does not disclose receiving a request to display a GUI object from a plug-in, Anderson cannot possibly disclose means for receiving, at run time, in the application from the plug-in a request to display a GUI object, wherein the application has standards of appearance for the GUI display as claimed here.

In addition to the fact that Anderson discloses no plug-in, there is another reason why Anderson does not anticipate the present claims: Anderson does not disclose standards of appearance for the GUI display. Because Anderson does not disclose standards of appearance for the GUI display, Anderson cannot be said to disclose means for receiving, at run time, in the application from the plug-in a request to display a GUI object, wherein the application has standards of appearance for the GUI display. In a system that controls a GUI display according to embodiments of the present invention, an application receives a request to display a GUI object where the application has standards of appearance for its GUI display. According to the claims, the GUI object is displayed in dependence upon an XML representation of the GUI object, where the XML representation complies with the application's standards of appearance for the GUI display. In contrast to the claims of the present application, as illustrated, for example, by the above-quoted excerpt from Anderson's column 2, Anderson makes no disclosure of controlling a GUI display with any standards of appearance. Anderson discloses only that a GUI object can be developed apart from Anderson's Business Logic objects and Enterprise Data Adapter objects in Anderson's multi-tiered applications. Anderson makes no disclosures relating to the appearance of the GUI objects, and Anderson at no point discloses that an application has a standard of appearance for a GUI display as claimed here. Because Anderson does not disclose standards of appearance for a GUI display, Anderson cannot possibly disclose means for receiving, at run time, in the application from the plug-in a request to display a GUI object, wherein the application has standards of appearance for

the GUI display as claimed here. Because Anderson does not disclose each and every element and limitation of Applicants' claims, Anderson does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

**Anderson Does Not Disclose Means For
Retrieving An XML Representation
Of The GUI Object In Response To
The Request That Complies With
The Application's Standards Of
Appearance For The GUI Display**

The Office Action takes the position that Anderson at column 11, lines 15-25, discloses the second element of claim 8: means for retrieving an XML representation of the GUI object in response to the request that complies with the application's standards of appearance for the GUI display. Applicants respectfully note in response, however, that what Anderson at column 11, lines 15-25, in fact discloses is:

> The basic premise here is that GUI objects have expressed interest in receiving certain categories of information and are capable of generating requests for information that may be of interest to other components. The model is not strictly limited to GUI components and Data access components. If you wish to place business logic components in the application, you may do that also. Typically, these will be introduced into the system not by the XML configuration file, but indirectly as one of the GUI or Data access components is instantiated. However, it is a simple extension to include business logic modules in the configuration file.

That is, Anderson at column 11, lines 15-25, discloses that business logic components may be introduced into the system by an XML configuration file. Anderson's business logic components which may be introduced into the system by an XML configuration file does not disclose means for retrieving an XML representation of the GUI object in response to the request that complies with the application's standards of appearance for the GUI display as claimed in the present application. Anderson does not disclose a XML representation of the GUI object. As discussed above, Anderson discloses that a GUI object is generated by a client bootstrap object that receives a configuration document. Anderson discloses that the configuration document can be an XML

document. Anderson, however, does not disclose that the XML configuration document is an XML representation of the GUI object. In fact, Anderson discloses that the XML configuration document is not an XML representation of the GUI object by disclosing that the "client bootstrap object retrieves the code" specified in the XML configuration document and instantiates the objects involved in the application to create the GUI object. Anderson at column 3, line 63. That is, Anderson's XML configuration document only specifies code to retrieve and objects to instantiate. Anderson's XML configuration document is not an XML representation of the GUI object itself, as claimed here. Because Anderson does not disclose an XML representation of a GUI object, Anderson cannot possibly disclose means for retrieving an XML representation of the GUI object in response to the request that complies with the application's standards of appearance for the GUI display as claimed in the present application.

In addition to the fact that Anderson does not disclose the second element of claim 8 because Anderson does not disclose an XML representation of the GUI object, Anderson, for identical reasons, also does not disclose the third element of claim 8: means for displaying the GUI object in dependence upon the retrieved XML representation of the GUI object. Because Anderson does not disclose an XML representation of a GUI object, Anderson cannot possibly disclose means for displaying the GUI object in dependence upon the retrieved XML representation of the GUI object as claimed here. Because Anderson does not disclose each and every element and limitation of Applicants' claims, Anderson does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

Anderson Does Not Enable Each and Every Element Of The Claims Of The Present Application

Not only must Anderson disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Anderson must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the

Applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Anderson places Applicants' claims in the possession of a person of ordinary skill in the art, Anderson is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102. As explained above, Anderson does not disclose each and every element and limitation of independent claim 8 of the present application. Because Anderson does not disclose each and every element, Anderson cannot possibly place the elements and limitations of the independent claims in the possession of a person of ordinary skill in the art. Anderson cannot, therefore, anticipate claim 8 of the present application.

Relations Among Claims

Independent claim 15 is a computer program product claims for controlling a GUI display for a plug-in in an application supporting plug-ins corresponding to independent system claim 8 that include "means, recorded on [a] recording medium, for" controlling a GUI display for a plug-in in an application supporting plug-ins. For the same reason that Anderson does not disclose or enable systems for controlling a GUI display for a plug-in in an application supporting plug-ins, Anderson also does not disclose or enable computer program products for controlling a GUI display for a plug-in in an application supporting plug-ins corresponding to independent claim 15. Independent claims 8 and 15 are therefore patentable and should be allowed.

Claims 9-14, and 16-21 depend from independent claims 8 and 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Anderson does not disclose or enable each and every element of the independent claims, Anderson does not disclose or enable each and every element of the dependent

claims of the present application. As such, claims 9-14, and 16-21 are also patentable and should be allowed.

Conclusion

Claims 8-21 stand rejected under 35 U.S.C. § 101 as claiming an abstract idea. As discussed above, Applicants' claims satisfy the requirements of 35 U.S.C. § 101. Claims 8-21 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 8-21.

Claims 8-21 stand rejected under 35 U.S.C. § 102 as being anticipated by Anderson. Anderson does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Anderson therefore does not anticipate Applicants' claims. Claims 8-21 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 8-21.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: <u>January 17, 2008</u>   By:
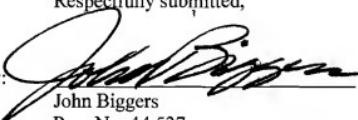
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